

INTERFERENCE DIGEST

Interference No. 105,599

Paper No.

Name: Se-Hwan Son et al.

Serial No.: 10/798,584

Patent No.

Title: Electronic device comprising organic compound having p-type semiconducting characteristics

Filed: 03/10/04

Interference with Ueno et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, _____ Dated, _____

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.



UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231MAILED
NOV 21 2007
PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Filed by: Judge Fred E. McKelvey
Telephone: 571-272-4683
Facsimile: 571-273-0042

Applicants: SON
Application No.: 10/798,584
Filed: 03/10/04
For: Electronic device comprising organic compound
having p-type semiconducting characteristics

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,599.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/FRED E. McKELVEY/
Administrative Patent Judge

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Paper 1
Entered: 21 November 2007

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE
5 BOARD OF PATENT APPEALS AND INTERFERENCES
6

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8 Patent Interference 105,599 McK
9 Technology Center 1700
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11
12 SE-HWAN SON, OK-HEE KIM, SEOK-HEE YOON,
13 KONG-KYEOM KIM, YOUN-GU LEE and JAE SOON BAE
14

15 Application 10/798,584,
16 US Patent Publication 2004/0169175 A1
17 Junior Party,
18

19 v.
20

21 KAZUNORI UENO, AKIHIRO SENOO,
22 and SEIJI MASHIMO,
23

24 Patent 6,436,559 B1,
25 Senior Party.
26

27 DECLARATION
28
29

Part A

Declaration of Interference

4 An interference is declared between the above-identified parties.

⁵ 35 U.S.C. § 135(a); 37 CFR § 41.203(b).

6 Details of the application, patent, count and claims designated as
7 corresponding or as not corresponding¹ to the counts appear in Parts E and F
8 of this DECLARATION.

Part B

Judge Managing the Interference

13 Senior Administrative Patent Judge Fred E. McKelvey has been
14 designated to manage the interference. 37 CFR § 41.104(a).

Part C Standing Order

19 A Trial Division STANDING ORDER (3 Jan. 2006) (Paper 2)
20 accompanies this DECLARATION.

21 The STANDING ORDER applies to this interference, including the
22 provisions related to Electronic Filing. See ¶ 105, pages 17-20.

¹ A claim of an involved application or involved patent which is *not* designated as corresponding to *any* count is not "involved" in the interference within the meaning of 35 U.S.C. § 135(a).

Part D

Initial Conference Call and Motions Lists

Conference Call

A conference call to discuss the interference is set for:

2:00 p.m. (1400 hours Eastern Time) on 17 January 2008.

The Board will initiate the conference call.

Motions Lists

On or before:

Noon (1200 hours Eastern time) on 10 January 2008,

12 each party shall file, and on or before:

5:00 p.m. (1700 hours Eastern time) on 10 January 2008,

14 each party shall serve a notice stating the relief the party requests, *i.e.*, a
15 motions list including motions the party seeks authorization to file. 37 CFR
16 § 41.120(a); STANDING ORDER ¶ 204 (Paper 2, page 58).

17 The default procedure for filing and serving motions lists is that
18 motions lists are to be *filed* before being *served*.

19 By filing before service, one party will not have access to an
20 opponent's motions list prior to the filing of the party's motions list.

21 Nevertheless, the parties may mutually agree to discuss and serve
22 motions lists at any time prior to the date and time motions lists are due.

23 The following shall be included in motions lists.

(2) Proposed motion to attack benefit must identify the application(s) to be attacked.

(a) if based on prior art, identify the prior art;

15 (4) Proposed motion based on no interference-in-fact shall
16 briefly identify the reason no interference-in-fact is believed to exist.

20 (6) Proposed motion to add or substitute a new count shall
21 explain why the added or substitute count is necessary.

22 A motions list shall not contain any "reservation clause" whereby a
23 party purports to reserve a right to file additional motions. Additional
24 motions are those authorized by the Board consistent with the rules.

25 A sample schedule for taking action during the motions phase of the
26 interference appears as Form 2 (page 69) of the STANDING ORDER.

1 Counsel are encouraged to discuss the schedule prior to the
2 conference and agree to on times for taking action generally consistent with
3 the sample schedule.

4 A typical motions phase last about eight (8) months.

5 The parties should be prepared at the conference to justify any request
6 for shorter or longer time periods.

7

Part E

**Identification of the Parties
Assignment of Exhibit Numbers
Initiating Settlement Discussions**

Junior Party

Inventors: Se-Hwan Son, South Korea
Ok-Hee Kim, South Korea
Seok-Hee Yoon, South Korea
Kong-Kyeom Kim, South Korea
Youn-Gu Lee, South Korea
Jae-Soon Bae, South Korea

Application: Application 10/798,584
filed 10 March 2004
US Publication 2004/0169175 A1
published 02 September 2004

Title: Electronic device comprising organic compound having p-type semiconducting characteristics

25 Real party in interest: LG Chemical Co., Ltd.

Senior Party

3 Inventors: Kazunori Ueno, Japan
4 Akihiro Senoo, Japan
5 Seiji Mashimo, Japan

7 Patent: U.S. Patent 6,436,559 B1²
8 issued 20 August 2002
9 based on application 09/708,479
10 filed 09 November 2000

14 Real party in interest: Canon Kabushiki Kaisha

Assignment of Exhibit Numbers

17 Senior party: Exhibit Numbers 1001 through 1999.

18 Junior party: Exhibit Numbers 2001-2999.

19 Board: Exhibit Numbers 3001-3999.

Initiating Settlement Discussions

STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)

24 The senior party is responsible for initiating settlement discussions

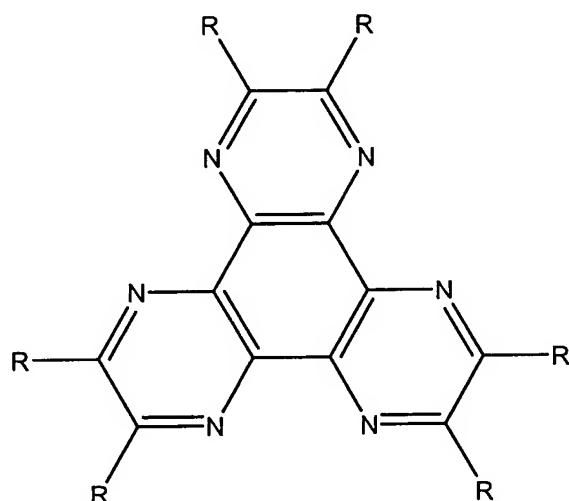
25 required by the STANDING ORDER.

² PTO's PALM data reveals that a \$900 maintenance fee was received in the PTO mailroom on 27 January 2006 (fee code 1551).

1
2 **Part F**
3 **Count and Claims of the Parties**

4 **Count 1**

5
6 An organic light-emitting device comprising one or more layers
7 interposed between an anode and a cathode, wherein one ore more
8 layers comprise an organic compound represented by the formula:
9



13 wherein each R is independently or simultaneously selected from the
14 group consisting of (1) hydrogen atom, (2) phenyl, and (3) alkyl having 1 to
15 8 carbon atoms.

16 The claims of the parties are:

17 Son: 1-4, 6-7, 9-16 and 18-20

18 Ueno: 1-19

19 The claims that correspond to Count 1 are:

20 Son: 1-4, 9-16 and 18-20

21 Ueno: 1 and 16-19

1 The claims that do not correspond to Count 1 are:

2
3 Son: 6-7

4
5 Ueno: 2-15

6

7 Observations concerning the interference

8 Count 1 has been designed to capture the common subject matter
9 claimed by the parties. Ueno describes preferred fused ring structures,
10 including tripyrazinocyclohexanes. Col. 3:46 *et seq.* Ueno compound 10
11 (col. 6) is a compound where all R's are simultaneously hydrogen. Ueno
12 compound 4 (col. 4) is a compound where all R's are simultaneously alkyl
13 with one carbon atom, i.e., methyl (—CH₃). Ueno compound 5 (col. 4) is a
14 compound where all R's are simultaneously phenyl. Ueno compound 6 (col.
15 5) is a compound where some R's are methyl and other R's are phenyl (thus
16 representative of the "independently" language of the count).

17 Son claims 6-7 have not been designated as corresponding to the
18 count because it is not apparent that the subgenus set out in the count would
19 render obvious the subgenus covered by Son claims 6-7. One item for
20 discussion at the conference call should be whether Son claims 6-7 should
21 be restricted out (35 U.S.C. § 121) and made the subject of a divisional
22 application. In the event Son prevails in the interference, is it not apparent
23 why Son should not get a windfall patent term adjustment for claims 6-7
24 if they are not going to be involved in the interference.

25 At the conference call, Son should be prepared to discuss how it, as
26 junior party, will prevail in the interference. *Cf.* 37 C.F.R. § 41.202(d).

Benefit for the purpose of priority

2 The parties are accorded an earlier constructive reduction to practice
3 (i.e., benefit for the purpose of priority) of the following applications:³

4 Son: Application 09/914,731
5 filed 30 August 2001
6 now U.S. Patent 6,720,573
7 issued 13 April 2004

PCT/KR00/01537
filed 27 December 2000

12 Ueno: None.

³ Son also claims priority of (1) South Korean patent application 2000-82085, filed 26 December 2000 and (2) South Korean patent application 1999-067746, filed 31 December 1999. Ueno claims priority of Japanese patent application 11-322820, filed 12 November 1999. If a party wants to be accorded benefit for the purpose of priority of these applications, the party should list a motion for benefit in the motions list. While the Examiner in a Form PTO-850 accorded benefit, the count adopted by the Board is considerably narrower than the count proposed by the Examiner and therefore benefit is not accorded at this time. The benefit which has been accorded is based on an assumption that the Son benefit applications are essentially identical in disclosure with the involved Son application.

Part H
Order Form for Requesting File Copies

When requesting file copies, a party shall use STANDING ORDER

4 Form 4 (page 71).

Use of form 4 will expedite processing of any request.

a party should attach to any request for file copies a photocopy of

7 Part E of this DECLARATION with a hand-drawn circle around the patent
8 and application files for which a copy of a file wrapper is requested.

The parties are advised that a single order for file copies may be filled

10 by the Office of Public Records at more than one time. STANDING

11 ORDER ¶ 109.2 (Paper 2, pages 25-27).

Part I

Required Paragraph of Affidavits and Declarations

16 The Board has experienced cases in which a witness has belatedly
17 advanced reasons why the witness would be unable to appear for cross
18 examination at a reasonable time and place in the United States.

Consequently, to prevent surprise and hardship to the party relying on the testimony of a witness, the following paragraph must be included on the signature page of all affidavits (including declarations) filed in this case.

22 STANDING ORDER ¶ 157.2 (Paper 2, pages 52-53).

23 In signing affidavit (declaration), I understand that the affidavit
24 (declaration) will be filed as evidence in a contested case before
25 the Board of Patent Appeals and Interferences of the United
26 States Patent and Trademark Office. I also acknowledge that I
27 may be subject to cross examination in the case and that cross
28

1 examination will take place within the United States. If cross
2 examination is required of me, I will appear for cross
3 examination within the United States during the time allotted
4 for cross examination.

5

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8

9 /ss/ Fred E. McKelvey _____)
10 FRED E. McKELVEY)
11 *Senior Administrative Patent Judge*)

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13

14 Entered at:

15

16 Kailua, HI

17 21 November 2007

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2
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